



Docket No.: 219928US0

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

OBLON
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McCLELLAND
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RE: Application Serial No.: 10/078,409

Applicants: Francine BALDO, et al.

Filing Date: February 21, 2002

For: COMPOSITION FOR TOPICAL APPLICATION
COMPRISING AT LEAST ONE
HYDROXYSTILBENE AND AT LEAST ONE
POLYOL TO SOLUBILIZE THE
HYDROXYSTILBENE

Group Art Unit: 1617

Examiner: G. Yu

SIR:

Attached hereto for filing are the following papers:

**REQUEST FOR RECONSIDERATION; and
PETITION FOR EXTENSION OF TIME (1 Month).**

Our credit card payment form in the amount of **\$110.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

Francine BALDO, et al. : EXAMINER: G. Yu

SERIAL NO: 10/078,409 :

FILED: February 21, 2002 : GROUP ART UNIT: 1617

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AND AT LEAST ONE POLYOL TO SOLUBILIZE THE
HYDROXYSTILBENE

REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS
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SIR:

In response to the Office Action mailed January 28, 2004, Applicants respectfully request reconsideration of the above-identified application in view of the following remarks.

As noted in the present specification, hydroxystilbenes have low solubility in cosmetic solvents and, in fact, tend to crystallize in cosmetic compositions. (See, e.g., page 3, lines 8-11). This crystallization/lack of solubility can hinder the hydroxystilbene's effectiveness/activity and can change the overall stability and/or appearance of the composition. (See, e.g., page 3, lines 11-15).

The present invention addresses these crystallization/lack of solubility problems associated with hydroxystilbenes. Specifically, the present invention relates to combining sufficient polyol with hydroxystilbenes to solubilize them, thereby increasing their effectiveness/activity. None of the cited art teaches or suggests this invention.

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The Office Action rejected (1) claims 1-5, 9, 14-17, 23-27, 31 and 36-40 under 35 U.S.C. §103 as obvious over U.S. patent 6,124,364 (“Breton”); (2) claims 6, 10-13, 18, 19, 21, 22, 28, 32-35, 41 and 42 under 35 U.S.C. §103 as obvious over Breton in view of U.S. patent 5,658,575 (“Ribier”); and (3) claims 1-9, 14-17, 20-31 and 36-42 under 35 U.S.C. §103 as obvious over U.S. patent 6,358,517 (“Pillai”).

In support of these § 103 rejections, the Office Action has asserted that the primary references (Breton and Pillai) generally disclose broad enough ranges for both the hydroxystilbene and the polyol such that one skilled in the art, based on these broad disclosures, could prepare a composition containing the claimed hydroxystilbene : polyol ratios. Moreover, the Office Action has asserted that no criticality exists for the claimed ratios, or that any unexpected advantages result from using the claimed ratios. Both of these assertions are incorrect and unsupported by the evidence of record.

Regarding the first assertion, Breton’s and Pillai’s broad, general disclosure concerning the possible combination of a hydroxystilbene and a polyol is insufficient to render obvious the claimed invention which relates to the specific combination of specific hydroxystilbene : polyol ratios.

First, neither Breton nor Pillai recognizes the importance of combining a hydroxystilbene with a polyol. Rather, Breton teaches that moisturizers (of which glycerin and butylene glycol are examples) could optionally be added to his compositions, (Breton at col. 5, lines 57-58), while Pillai teaches that emollients such as polyols could optionally be added to his compositions. (Pillai at col. 3, lines 58-63). Thus, both Breton and Pillai teach/suggest optionally combining hydroxystilbenes with compounds having

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moisturizing/emollient properties regardless of what those compounds are (as long as they are moisturizers/emollients). Any moisturizer/emollient would suffice. In other words, neither Breton nor Pillai attaches any significance to specifically combining a hydroxystilbene with a polyol.

Second, neither Breton nor Pillai discloses or suggests combining at least one hydroxystilbene with an amount of polyol sufficient to solubilize the hydroxystilbene. Breton does not disclose concentration ranges for the moisturizers which could optionally be added to his compositions. (See, Breton at col. 5, lines 57-58). Thus, contrary to the Office Action's assertion, Breton does not teach adding a "general range" of 1-7% polyol to his compositions. Rather, Breton's only teaching concerning polyol concentration relates to the relative ratios of hydroxystilbene and polyol provided by the particular ratios of these two compounds in the examples. In these examples, Breton discloses compositions containing polyol and hydroxystilbene in ratios no greater than 10:1. Accordingly, one skilled in the art, seeking to combine polyol with hydroxystilbene in accordance with Breton's disclosure, would not be motivated to create general polyol concentration ranges not disclosed by Breton and then experiment with various combinations within such ranges. Instead, one skilled in the art would follow Breton's disclosure, using at most a 10:1 polyol : hydroxystilbene ratio. Such ratios are insufficient to effect hydroxystilbene solubilization and, thus, cannot render the claimed invention obvious.

Similarly, Pillai's only teaching concerning polyol concentration relates to the relative ratios of hydroxystilbene and polyol provided by the particular ratios of these two compounds in Pillai's example 5, where the ratio is a mere 1.5:1. Pillai's general disclosure concerning

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concentration ranges for resveratrol and for emollient are too general to provide guidance concerning the specific combination of hydroxystilbene and polyol being claimed. Moreover, even assuming that one skilled in the art would theoretically be motivated to experiment with Pillai's broad, general ranges, nothing in Pillai would motivate one skilled in the art to focus on a small, specific portion of such ranges to arrive at the specific ratios of the claimed invention.

Regarding the second assertion, criticality does, in fact, exist for the claimed ratios. This criticality is demonstrated in the examples on pages 27-30 of the present application in which the disclosed compositions having a ratio of 150:1 result in hydroxylstilbene solubilization, but the disclosed compositions having a ratio of 100:1 or less do not. These examples show that compositions having a ratio of 150:1 (claims 1-22) and that compositions having a hydroxystilbene solubilization effective amount of polyol (claims 23-42) lead to hydroxystilbene solubilization, whereas smaller ratios of hydroxystilbene and polyol (such as those disclosed in Breton (10:1) and Pillai (1.5:1)) do not. By themselves, these examples and the criticality of the claimed invention which they demonstrate are sufficient to show that the claimed invention is not obvious and to overcome the § 103 rejections.

Finally, with regard to claims 23-42, these claims require the presence of a hydroxystilbene solubilizing effective amount of at least one polyol. This “effective amount” limitation is a real limitation which must be taught or suggested by prior art before a proper prior art rejection can be made: that is, the cited art must teach or suggest solubilizing hydroxystilbene with polyol. See, *Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*, 67 U.S.P.Q.2d 1191 (Fed. Cir. 2003). As noted above, neither Breton nor Pillai

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discloses, suggests or recognizes the significance of polyol's ability to solubilize hydroxystilbene, or the criticality of combining sufficient polyol with hydroxystilbene to achieve such solubilization. In view of Abbott, the cited art cannot render these claims obvious.

Ribier cannot compensate for Breton's or Pillai's deficiencies. Ribier does not disclose or suggest compositions containing both a hydroxystilbene and a polyol, nor does Ribier disclose or suggest solubilizing hydroxystilbenes with polyols.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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